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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,329	09/18/2003	Thomas Richard Tepe	A01446	6250
21898	7590	07/05/2005		
			EXAMINER	
			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/665,329	TEPE, THOMAS RICHARD	
	Examiner Vickey Ronesi	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 April 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-18 are now pending in the application.
2. The outstanding claims objections over claims 1, 2, and 9 and the 35 USC 112(2) rejections over claims 1- 10 are withdrawn in light of applicant's amendment filed 4/22/2005.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 4/22/2005. In particular, the amounts of comonomer in the copolymer has been amended with the term "by weight" and claims 11-18 have been added. Thus, the following action is properly made final.

### ***Claim Objections***

5. Claim 3 is objected to because the amount of clay in the composition is still without basis, i.e., is it % based on weight or volume? Support for % by weight based on the entire composition is given on page 2, line 2-3. Please indicate such in the claim language.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 4-7, and 9-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1, 4-7, and 10-18, there is no support in the disclosure as originally filed that the percentage monomer is weight percent. Applicant's statement on page 5 of the amendment filed 4/22/2005 that on page 2 there is a statement that the percentage monomer is weight percent is erroneous since no such statement was found. Regardless, a statement by the applicant stating that the percentages are based on weight is insufficient. To overcome this rejection, applicant is advised to provide a declaration filed under 37 CFR 1.132 with an appropriate statement and objective evidence that supports applicant's statement.

With respect to claim 7, while "colloidal range" may be defined as 1-1000 nm in the McGraw-Hill Dictionary of Chemistry, the insertion of the term "from 1 to 1000 nm" lacks support in the original disclosure and is thereby considered to be new matter.

With respect to claim 9, applicant does not have support for any viscosity measurement, only low-shear viscosity measurements. Although the deletion of the term "low-shear" from the claim overcomes the 35 USC 112(2) rejection, nevertheless, such a deletion results in new matter.

#### *Claim Rejections - 35 USC § 103*

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laryea et al ("Stabilized Shampoo/Surfactant Suspensions," cited on IDS dated 12/29/2003) in view of

Merritt et al (US 5,057,241) and either Gardlik et al (US 2002/0035070) or Dowell et al (US 5,587,154).

The rejection is adequately set forth in paragraph 3 of Office action mailed 2/24/2005 and is incorporated here by reference. The rejection is sufficient to encompass new claims 11-18.

### ***Response to Arguments***

8. Applicant's arguments filed 4/22/2005 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Aculyn 28 does not provide the desired increase in viscosity in a high-surfactant formulation and is therefore outside the scope of the presently claimed invention and (B) that since Merritt teaches away from selecting acrylic acid and does not disclose an alkyl (meth)acrylate in its composition, there is no motivation to combine Laryea et al with Merritt.

With respect to argument (A), applicant's declaration which provides for a comparison between the viscosity change of a composition comprising Aculyn 28 and a select few of applicant's exemplified examples has been considered, however, it is insufficient to overcome the pending 35 USC 103 rejection. While the examiner agrees that applicant's data on the declaration filed 4/22/2005 comparing Aculyn 28 to select inventive examples clearly show a significant difference in viscosity change values, the relative amounts of comonomer in the noted copolymers is not commensurate in scope with the presently claimed amounts of comonomer. In particular, the amount of acrylic acid residues is from 20-30 %, the amount of methacrylate residues is from 60-70 %, and the amount of lipophylically modified comonomer is 10 %. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope

with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Furthermore, applicant's attention is drawn to Table 1 of the present specification where other examples which also fall within applicant's presently claimed scope of copolymers do not provide for the desired viscosity change. In fact, all other examples provide for a copolymer composition with a copolymer with amounts of comonomer that fall within the scope of the present claims wherein the viscosity change values are either about or less than the viscosity change values of Aculyn 28.

Thus, it has not been clearly established if Aculyn 28 falls outside of the scope of the present claims. Without knowing the relative amounts of comonomer in Aculyn 28 and without a clear showing that Aculyn 28 exhibits properties that fall outside the scope of the present invention, the rejection will be maintained.

With respect to argument (B), Merritt is utilized for its teachings regarding relative amounts of monomer, on which Laryea was silent. Merritt was not intended or required to teach the specific combinations of comonomer in the copolymer--that was provided by the primary reference, Laryea. Specifically, the relative amounts are taught on col. 8, line 58 to col. 9, line 50: 15-60 wt % of at least one methacrylic or acrylic acid (col. 8, line 68 to col. 9, line 8); 15-80 wt % of methyl methacrylate residues (col. 9, lines 9-33); and 1-30 wt % of nonionic vinyl surfactant ester (i.e., lipophilically modified methacrylate) (col. 9, lines 34-50).

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Contact Information*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/27/2005

vr



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